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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,427	09/22/2003	Susan Davis	0118/001	8623

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Steven W. Webb
Law Offices of Steven W. Webb
655 2nd Street
Encinitas, CA 92024

EXAMINER

ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,427

Applicant(s)

DAVIS ET AL. *m*

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claim 5 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed 4/12/2004.

Drawings

2. The drawings are objected to because Fig. 13 is not shown on any of the drawing sheets. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 2, 3 are objected to because of the following informalities:
Claims 2 and 3, line 2, the "." In between the terms "elements" and "are" should be removed. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regard to claim 4, the specification does not disclose the sticky abrasive substance emitting a bug-repelling odor.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4, 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, lines 5, 6, 8, 9, and 11, the term "the shield element" renders the claim vague and indefinite since "a plurality of shield elements" and "each shield element" were previously set forth. These terms should be changed to "each shield element".

In regard to claim 1, line 11, the term "the top portions of the shield element front surface" lacks positive antecedent basis.

In regard to claim 6, line 3, the phrase "providing a plurality of shield elements..." renders the claim vague and indefinite since it fails to further modify the "pest shield system". The phrase should be rewritten as "providing the pest shield system comprising a plurality of shield elements..."

In regard to claim 6, the term "the border of a garden" lacks positive antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morisset 5,111,610.

Morissett discloses a plurality of shield elements (12', 12") each with a rectangular shape (see Fig. 4) with flat front and back surfaces; the bottom edge having sharp ridges (28) and capable of being inserted into the ground; the front surface of the shield element partially covered with a sticky substance (latex adhesive) embedded with grit (diatomaceous earth), the sticky substance with grit confined to a top portion of the each of the elements (not on bottom edge of 12' or 12" and also not no 28).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 3, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Keller 2,062,789 in view of Fuller 256,561 or Krolick 5,644,998.

Keller discloses a plurality of shield elements (5) each with a rectangular shape (see Fig. 3) with flat front and back surfaces; the bottom edge having sharp ridges (corners of 7) and capable of being inserted into the ground; the front surface of the shield element partially covered with a sticky substance (barrier of sticky material 11), the sticky substance confined to a top portion of the each of the elements (see Figs. 1-3), but does not disclose the sticky substance embedded with grit. Fuller discloses an insect barrier (A) with a sticky substance (tallow or other soft or sticky substance) embedded with grit (sand). Krolick discloses mulching materials (1) with adhesive applied to adhere an abrasive substance (7) which is a material which irritates, dehydrates, or lacerates bodies of insects such as snails and slugs and can be for example diatomaceous earth. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the sand of Fuller or the abrasive substance such as diatomaceous earth of Krolick in the sticky substance of Keller in order to provide a slippery surface that causes insects to loose their footing in their attempt to reach the plants or that will injure the insects when the insects either attempt to traverse the abrasive substance or ingest it.

In regard to claims 2 and 3, Keller discloses folds and perforations (at 4).

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keller 2,062,789 in view of Fuller 256,561 as applied to claim 1 above, and further in view of Hand et al. 5,353,556.

Keller and Fuller do not disclose the sticky substance emitting a bug-repelling odor. Hand et al. discloses a barrier for preventing crawling insects or pests from gaining access to plants which may have a repellant placed on either or both of the inside surfaces (47, 17) or may be placed in receptacles (81, 83). It would have been obvious to a person of ordinary skill in the art to modify the sticky substance of Keller and Fuller such that it emits a bug-repelling odor in view of Hand et al. in order to provide a further deterrent to insects so as to deter them from gaining access to protected plants.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Keller 2,062,789 in view of Fuller 256,561 or Krolick 5,644,998.

Keller discloses a plurality of shield elements (5) each with a rectangular shape (see Fig. 3) with flat front and back surfaces; the bottom edge having sharp ridges (corners of 7) and capable of being inserted into the ground; the front surface of the shield element partially covered with a sticky substance (barrier of sticky material 11), the sticky substance confined to a top portion of the each of the elements (see Figs. 1-3), but does not disclose the sticky substance embedded with grit. Fuller discloses an insect barrier (A) with a sticky substance (tallow or other soft or sticky substance) embedded with grit (sand). Krolick discloses mulching materials (1) with adhesive applied to adhere an abrasive substance (7) which is a material which irritates, dehydrates, or lacerates bodies of insects such as snails and slugs and can be for example diatomaceous earth. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the sand of Fuller or the

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abrasive substance such as diatomaceous earth of Krolick in the sticky substance of Keller in order to provide a slippery surface that causes insects to loose their footing in their attempt to reach the plants or that will injure the insects when the insects either attempt to traverse the abrasive substance or ingest it.

Alternatively, Keller and Fuller or Krolick do not disclose placing the shield elements along the border of a garden. Harvey et al. discloses a snail and slug deterrent barrier which deters the entrance of snails and slugs into an enclosed area and comprises a garden border (rigid strip of agricultural edging 20) to enclose a selected area. It would have been obvious to a person of ordinary skill in the art to modify the method of Keller and Fuller or Krolick by placing the shield elements along the border of a garden instead of a single plant in order to be able to protect a plurality of plants in a garden from pests.

14. Claims 1-3, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Harvey et al. 5,337,513 in view of Brookman 1,591,509 and Fuller 256,561 or Krolick 5,644,998.

Harvey et al. discloses a plurality of shield elements (20) each with a rectangular shape (see Fig. 2 wherein the lower section below the scalloped edge is like a rectangle; also see col. 5, line 48 "A wide variety of agricultural edging 20 is available) with flat front and back surfaces; the bottom edge capable of being inserted into the ground; the front surface of the shield element covered with a deterring material (particulate copper material), the material confined to a top portion of the each of the elements (see Fig. 3c), but does not disclose the bottom edge having sharp ridges or

the front surface of the shield element covered with a sticky substance embedded with grit. Brookman discloses means for defining edges of flower beds (1) having a bottom edge with sharp ridges (2) to cause easy entry into the ground. It would have been obvious to a person of ordinary skill in the art to employ the sharp ridges of Brookman on the bottom edge of Harvey et al. in order to provide means for easily entering the ground. Fuller discloses an insect barrier (A) with a sticky substance (tallow or other soft or sticky substance) embedded with grit (sand). Krolick discloses mulching materials (1) with adhesive applied to adhere an abrasive substance (7) which is a material which irritates, dehydrates, or lacerates bodies of insects such as snails and slugs and can be for example diatomaceous earth. It would have been obvious to substitute the particulate copper material of Harvey et al. for the sticky substance embedded with grit of Fuller or Krolick in order to provide a slippery surface that causes insects to loose their footing in their attempt to reach the plants or that will injure the insects when the insects either attempt to traverse the abrasive substance or ingest it and also to provide an alternative deterring material which is cheaper than copper.

In regard to claim 3, Harvey et al. and Brookman and Fuller or Krolick disclose folds in the sheet material (3 of Brookman) separating shield elements, but do not disclose perforations separating the shield elements. It would have been an obvious matter of design choice to employ perforations to separate the shield elements since applicant has not disclosed that by doing so produces any unexpected results or is critical to the design, and because perforations would allow the user to easily bend the device such that it conforms to the perimeter of the garden or area to be protected.

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey et al. 5,337,513 in view of Brookman 1,591,509 and Fuller 256,561 or Krolick 5,644,998 as applied to claim 1 above, and further in view of Hand et al. 5,353,556.

Keller, Brookman, and Fuller or Krolick do not disclose the sticky substance emitting a bug-repelling odor. Hand et al. discloses a barrier for preventing crawling insects or pests from gaining access to plants which may have a repellent placed on either or both of the inside surfaces (47,17) or may be placed in receptacles (81, 83). It would have been obvious to a person of ordinary skill in the art to modify the sticky substance of Keller, Brookman and Fuller or Krolick such that it emits a bug-repelling odor in view of Hand et al. in order to provide a further deterrent to insects so as to deter them from gaining access to protected plants.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mercer '568 discloses an ant trap wherein the outer surface of the receptacle is provided with a coating comprised of a mixture of paint and sand so as to provide a foothold for ants; Thum '276 discloses sticky fly-paper where the object is to prevent the sticky material from spreading or running over the clean margin and onto the back of sheets by coarse sand to keep the sticky substance from flowing over the surface.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark
Primary Examiner
Art Unit 3643

DWA